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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.            | CONFIRMATION NO.       |
|---|-------------|----------------------|--------------------------------|------------------------|
| 10/605,577  | 10/09/2003  | Muhammed Majeed      |                                | 2576                   |
| 33048   | 7590        | 09/26/2007           |                                |                        |
| SABINSA CORPORATION<br>70 ETHEL ROAD WEST<br>UNIT 6<br>PISCATAWAY, NJ 08854 |             |                      | EXAMINER<br>MERCIER, MELISSA S |                        |
|   |             |                      | ART UNIT<br>1615               | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>09/26/2007        | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 10/605,577             |  | MAJEED ET AL.       |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Melissa S. Mercier     |  | 1615                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 19, 2007 has been entered.

### **Summary**

Receipt of Applicants Remarks and Amended claims filed on September 19, 2007 is acknowledged. Claims 14 and 17-19 are pending in this application.

### ***Claim Objections***

Claim 17 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 15. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The only difference between the two claims is the intended function of the composition. **Applicant is reminded that the intended function/future use of the claimed composition does not hold patentable weight.**

***Claim Rejections - 35 USC § 112***

Claims 18-19 provide for the use of a composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

Claims 18-19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent 5,972,357).

Yamaguchi teaches health foods and cosmetics containing polyisoprenylated benzophenone derivatives." The derivatives may be prepared by any method such as the chemical synthetic method or the extraction of the polyisoprenylated benzophenone derivatives from the plant containing them. The preferred derivatives includes, for

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example, well known substances such as Garcinol also known as Camboginol, isogarcinol also known as Cambogin, xanthochymol, and guttiferone" (column 3, lines 14-24). Yamaguchi further teaches, "the plants containing the polyisoprenylated benzophenone derivatives described are some kind of tropical plants belonging to the Guttiferae family, for example *Garcinia cambogia*, *Garcinia indica*, and *Garcinia purpurea*" (column 3, lines 28-33).

Yamaguchi's example 1 is drawn to a healthy drink with extracts. The example teaches " In the same manner as in Referential Example 1, the hydroxycitric acid extracted residue of the dry rind of the *Garcinia indica* was extracted with ethanol to give an extract containing 25% w/w of garcinol and 5% w/w of isogarcinol" (column 12, lines 56-61). The Referential Example 1 can be found in Column 6, lines 4-44.

Yamaguchi also teaches "the derivatives are effective ingredients and have a variety of functions for maintaining health such as anti-ulcer activity, the Maillard reaction inhibiting activity, anti-oxidation activity, reactive oxygen species scavenging activity and anti-tumor promotion activity" (abstract). The derivatives are also expected to have "prophylactic effects on various geriatric diseases, stress diseases, diabetic diseases, tumorigenesis and the aging of skin, such as hardening, wrinkling, and pigmentation" (column 2, lines 45-55).

Yamaguchi does not disclose a composition comprising 3% Garcinol and 2% Cambogin.

Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general

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conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. See *In re Russell*, 439 F.2d 1228 169 USPQ 426(CCPA 1971).

Claims 14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majeed et al (PCT Publication WO 2002/14477, now US Patent 7,063,861).

Majeed teaches a composition comprising hydroxycitric acid (HCA) in combination with either one or both of Garcinol and antrocyenin. Garcinol is described as having well know anti-oxidant effects, an aid to weight loss, chemopreventive properties, inhibition of cytoplasmic citrate lysase. Majeed additionally teaches a method for extracting Garcinol by "extracting Garcinia spent fruit from suspension with toluene and 5% methanol to obtain a paste having 20% PPB's (Garcinol-15%; Cambogin 5%" (column 6, lines 14-19). In additional steps outlines, Majeed further teaches the purification of the Cambogin and Garcinol to increase the percentage of each present in the composition.

Majeed does not disclose a composition comprising 3% Garcinol and 2% Cambogin.

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Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. See *In re Russell*, 439 F.2d 1228 169 USPQ 426(CCPA 1971).

### ***Response to Arguments***

Applicant's remarks have been fully considered but are not deemed to be persuasive. As was discussed above, the instant claims are drawn to a composition, not a method of treatment. The intended use or future function of the composition does not hold patentable weight. Based on the rejections above, the composition has been deemed to be obvious to a person of ordinary skill in the art at the time of the invention. Applicant is additionally reminded that the prior art references are considered as a whole and not only based on the claims of the prior art reference.



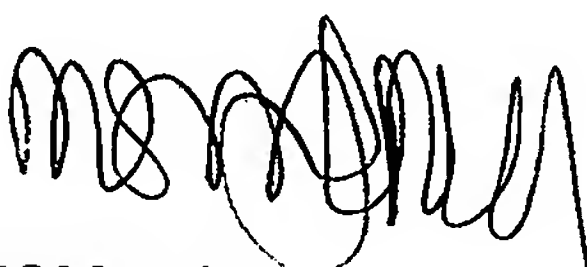
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***Conclusion***

No claims are allowable. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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